



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/335,461 11/07/94 GIERSET

R

18N2/1202

RICHARD J WARBURG
LYON & LYON
633 WEST FIFTH STREET SUITE 4700
LOS ANGELES CA 90071-2066

EXAMINER

LOW, C

ART UNIT

PAPER NUMBER

1804

21

DATE MAILED:

12/02/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D. C. 20231

BEFORE THE BOARD OF PATENT
APPEALS AND INTERFERENCES

Examiner: Low
Art Unit: 1804

Application Serial Number: 08/335,461
Filing Date: 7 November 1994
Appellant(s): Gjerset *et al.*

PAPER NO.: 21

*Mailed
Dec. 2, 1997
Group 1800*

Anthony C. Chen
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's
reply brief filed on 6 October 1997

The reply brief filed 6 October 1997 is noted as identifying the present application as having the serial number 08/355,461. The present application has a serial number that is 08/335,461. It is presumed that the error is typographical.

- 5 Appellant's reply brief identifies two (2) arguments (reply brief page i) pursuant to 37 C.F.R. 1.193(b) and asserts these are new. They are not new. The reasons are as follows.

At page 1, appellant's reply brief discusses normal as opposed to wild type cells. Appellant's assertions at pages 2-3 of the reply brief have been considered but are unpersuasive as to the argument that reduction in tumor burden is not applicable. Appellant has provided no other method of use for the claimed process which the present application disclosed as only for treating cancer. Insofar as claim 1 is as argued in the reply brief is directed to increasing the therapeutic effect, the tumor cells are treated to the same tumor therapy, however, there are, when the cells express the wild type p53 gene product, they are less to not tumorigenic. Where appellant argues the same tumor cells are treated with a cancer therapy, the cancer therapy is directed to killing cancer cells, not normal cells. The assertions in the reply brief are not persuasive nor commensurate to the requirements of 37 C.F.R. 1.193(b) which state that the reply brief must be confined to new points of argument or address a new ground of rejection. The instant examiner's answer contains neither.

- 20 As to the argument (reply brief page 3-4) that it is not obvious that a gene that suppresses tumor growth would sensitize tumor cells to routine cancer therapies, the comments are unpersuasive. The reply brief refers to two modalities suppressing tumor growth and increasing sensitivity. In this regard, appellant argues that suppression cannot be equated with enhancement of sensitivity. The comment is unpersuasive. In both instances, the identical structural gene, that gene which encodes wild type p53. The gene is the same as that used in the cited prior art. The identical chemical compound/composition is expected to have the identical chemical, physical, and biological properties and functions. A chemical (or a compound or a composition) is inseparable from chemical, physical, and biological properties and functions. Thus, the comments in the paragraph bridging pages 3-4 of appellant's reply brief are unpersuasive.


In the paragraph bridging pages 4-5, the reply brief refers to two other suppressor genes, Rb and p16 as showing resistance to cisplatin and other chemotherapeutic agents. It is also noted that the reply brief refers to references by Shimizu *et al.* and Stone *et al.* as to Rb and p16 respectively. Neither Rb nor p16 are p53 nor have p53 function. Neither the Shimizu *et al.* nor the Stone *et al.* references are directed to p53. Neither the Shimizu *et al.* nor the Stone *et al.* even discuss p53 nor do either reference extrapolate to other suppressor genes. The assertions in the reply brief are not persuasive nor commensurate to the requirements of 37 C.F.R. 1.193(b) which state that the reply brief must be confined to new points of argument or address a new ground of rejection. The instant examiner's answer contains neither.

Neither of appellant's arguments address new points of argument nor address a new ground of rejection and therefore, do not comply with the requirements of 37 C.F.R. 1.193(b). As pointed above, even where the reply brief is considered, it is unpersuasive.

For the above reasons, it is believed that the rejections should be affirmed.

Respectfully submitted,

Christopher Low
25 November 1997


CHRISTOPHER S. F. LOW
PRIMARY EXAMINER
GROUP 1800